

Application No. 10/026,329

REMARKS

The above-identified patent application has been reviewed in light of the Examiner's Action mailed 31 March 2003 (Paper No. 6). Claims 1-21 were pending. Claims 11-21 have been withdrawn from consideration. Claims 1, 3, 5-7 and 10 have been amended herein. Claim 9 has been cancelled without intending to abandon or to dedicate to the public any patentable subject matter. Accordingly, following entry of the foregoing amendments, Claims 1-8 and 10 will be pending. As set forth more fully below, reconsideration and withdrawal of the Examiner's rejections of the claims are respectfully requested.

Priority Oath/Declaration

The Examiner notes that the patent office records continue to reflect a different filing date than that recited by the specification and the declaration submitted therewith. Applicants' counsel previously attempted to correct the filing date for the provisional application Serial No. 60/257,917 from which the present application claims priority. Although the patent office corrected the city and state of residence at that time, the records were not corrected regarding the filing date.

Applicants again submit a request to correct the filing records of the USPTO to reflect the correct filing date of the above-referenced provisional patent application in agreement with the specification and declaration of record for the present utility application.

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Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected Claims 1-10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the Examiner notes that the recitation of "the materials" in Claim 1 lacks antecedent basis. Applicants have amended Claim 1 to remove recitation of the "materials" and have further amended Claim 1 to recite the formation of a specific product, i.e. a "suspension" in step b.

Applicants have amended Claims 1, 3, 5-7 to recite the final product of Claim 1 (i.e. a metallic colloid) and deleted reference to the "product material" in the claims. Additionally, Applicants have cancelled Claim 9 as the exact chemical identity of the dispersants sold under the SOLSPERSE® and DISPERBYK® trademarks cannot be ascertained (see, for example, U.S. Patent Nos. 5,349,010 and 5,108,863). Applicants submit that this amendment is made without intending to dedicate to the public any patentable subject matter. As noted in the specification, the dispersants sold under the trademarks SOLSPERSE® and DISPERBYK® are examples of the broader class of dispersants functional in the instantly claimed methods.

Applicants have also amended Claim 10 to recite a proper Markush group. Applicants therefore submit that Claims 1-8 and 10, as amended, are sufficiently definite to meet the requirements of 35 U.S.C. § 112, second paragraph.

Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected Claims 1-2 and 5-10 as being obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 4,080,177 (Boyer). Boyer teaches a method of forming a

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magnesium suspension in kerosene for use as jet fuel. The Examiner argues that it would have been obvious to modify the method of Boyer to produce the instantly claimed method of the present invention.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants note that the instant Claim 1 and claims dependent therefrom, require supplying the elemental metal in a size range of 1-10 microns. The Boyer reference teaches the use of 400 mesh magnesium metal containing aluminum, copper, iron manganese and nickel contaminants (see Column 3, lines 52-55). This mesh size is equivalent to approximately 35-40 microns, and therefore, the method of Boyer teaches the use of a starting material outside the presently claimed description of a suitable starting material. Additionally, Boyer does not disclose the presently claimed step "e" of agitating the comminuted mixture to produce the nanoscale metallic colloid. Therefore, Applicants submit that Boyer does not teach or suggest all of the claim limitations of the instant claims and respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

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Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

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